



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,747	10/24/2000	Roger D Melen	4863(CFP1587US)	1555

5514 7590 09/30/2003

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
----------

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/695,747

Applicant(s)

MELEN ET AL.

Examiner

Mary Cheung

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of the Claims***

1. Claims 1-38 are pending. Claims 1-2, 5, 9, 12, 14-15, 19-20, 24-30 and 38 have been amended.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-23 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "...intended for said based on data provided by said recipient..." in lines 10-11 of the claim. It is not clear what "said based on data" mean. For examination purpose, this sentence is considered as "...intended for said recipient based on data provided by said recipient...".

Claims 2-23 are rejected for incorporating the errors of their respective base claims by dependency.

### ***Response to Arguments***

4. Applicant's arguments filed July 31, 2003 have been fully considered but they are not persuasive.

All applicant's arguments are based on believing the cited prior art fail to teach accumulating a document folder which is sent from a sending device at a destination location selected based on data provided by the recipient. Examiner believes this

Art Unit: 3621

matter is taught by Barker et al. (U. S. Patent 6,233,252) as accumulating document fragments of a large size file sent from a sending device at a destination location selected based on data provided by the recipient (column 2 line 46 – column 3 line 62). In response to the applicant's argument that Barker does not permit its recipients to designate a destination location, Barker specifically states "Once the very large data file (digital motion picture file) is reconstructed using the file conversion software 11a, it may be archived or processed in any desired manner. For example, the reconstructed digital motion picture file may be transferred to a digital project 16 so that it may be display to an audience", that corresponds to this limitation (column 3 lines 13-18).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 5, 8, 10, 23-30 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Barker et al., U. S. Patent 6,233,252.

As to claim 1, Barker teaches a method for distributing document folders (document fragments or large size documents) to recipients, said method comprising (abstract):

- a) Temporarily storing an electronic document folders sent from a sending device, the electronic folder comprising at least one document is taught by Barker as a large size document or document fragments are sent from a sending device, the large size document comprising at least one document fragment, and said document fragments are later to be reconstructed to the original scheme (column 2 line 53 – column 3 line 29 and Fig. 1);
- b) Notifying a recipient that an electronic document folder is intended for said recipient by providing an indirect reference to the electronic document folder intended for said recipient is taught by Barker as a recipient receives document fragments, and each document fragment has an indirect reference (column 3 lines 26-31);
- c) Selecting a destination location for the recipient to receive the document fragment intended for said recipient based on data provided by said recipient, the data including information with regard to the destination location for the recipient (column 2 line 60 – column 3 line 19 and Figs. 1-2);
- d) Accumulating the temporarily stored document fragments at the selected destination location (column 3 lines 4-18, 52-62 and Fig. 2).

As to claim 5, the indirect reference to the electronic document folder comprises a folder code containing information needed to retrieve the electronic document folder is taught by Barker as the indirect reference to the document fragment containing information needed for retrieving the document (column 3 lines 26-30, 58-62).

Art Unit: 3621

As to claim 8, Barker teaches modifying (fragmenting) data for the best recipient use with regard to capabilities of a receiving device at said destination (abstract and column 3 lines 26-29).

As to claim 10, Barker teaches a recipient retrieving an electronic document fragment based upon providing information contained in said indirect reference (column 3 lines 26-29, 58-62).

As to claim 23, converting a sent electronic document folder into a page description language before sending a link to the electronic document folder to a recipient is taught by Barker as fragment the document to smaller sizes before delivering it a recipient (column 3 lines 26-29 and Fig. 1).

As to claim 27, Barker teaches at least one of device is from the group comprising a scanner, a facsimile machine, and a computer (Fig. 1).

As to claim 28, Barker teaches the receiving device is from the group comprising a web-enabled personal computer, a web-enabled printer, a web-enabled digital copier, and a web-enabled Internet appliance (Fig. 1).

Claims 24-26, 29-30 and 38 are rejected for the similar reasons as claims 1, 5, 8, 10 and 23.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 17 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barker et al., U. S. Patent 6,233,252.

As to claim 17, Barker does not explicitly teach the document folders are sent using virtual private network security. It would have been obvious to one of ordinary skill in the art to allow the method document folders to Barker to be sent through virtual private network security because this commonly used network system would allow the user securely transferring information.

As to claims 21-22, Barker does not explicitly teach sending a notification via email or over a cellular phone. It would have been obvious to one of ordinary skill in the art to allow Barker to delivery a notification by these commonly known method (via email or over a cellular phone) so that the recipient can quickly and economically receive a notification.

10. Claims 2-4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barker et al., U. S. Patent 6,233,252 in view of Miller et al., U. S. Patent 6,151,696.

As to claims 2-4, Barker teaches a method for distributing document fragments to recipients as discussed above. Barker does not explicitly teach the data provided by the recipient is selected from the group consisting of document reception address data and additional document reception data. However, Miller teaches the data provided by a recipient consisting of document reception address data and additional document reception data (column 4 lines 12-16 and column 6 lines 30-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the data provided by the recipient in Barker to include document reception address data and additional document reception data so that the document fragment can be better distributed to the recipients.

As to claim 9, Barker teaches a method to securely distribute document fragments to recipients as discussed above. Barker does not specifically teach sending acknowledgment to a sender. However, Miller teaches this matter (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the method of Barker to send acknowledgment to a sender because it would allow the sender to know the status of the transmitted documents so that the documents would be transmitted more efficiently.

11. Claims 6-7, 11-16 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barker et al., U. S. Patent 6,233,252 in view of Kovnat et al., U. S. Patent 5,619,649.

As to claim 6, Barker teaches folder code as discussed above. Barker does not specifically teach the folder code is a privacy code. The privacy code is taught by



Art Unit: 3621

Kovnat as a pin number. Kovnat teaches each information (job) is assigned to a pin number, and user needs to the pin number to retrieve the information (Figs. 16-17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the folder code (or the indirect reference) of Barker to be a pin number so that only the authorized user can retrieve the information.

As to claim 7, Barker teaches folder code as discussed above. Barker does not specifically teach the folder code is a mediocard data, said media card data delivered to each recipient prior to said recipient's accessing an electronic document folder. Kovnat teaches each information (job) is assigned to a pin number, and user needs to the pin number in order to access the information (Figs. 16-17). Kovnat does not specifically teach the pin number is mediocard data; however, it well known in the art the pin number is can be issue on paper, on a card, or through email, etc. It would have been obvious to one of ordinary skill in the art to allow the pin number to be issue on a mediocard so that the recipient can carry around for remotely accessing the information. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the folder code (or the indirect reference) of Barker to be a media data so that only the authorized user can retrieve the information.

As to claims 11-14, Barker does not specifically teach authentication step. However, Kovnat teaches authentication step (Figs. 16-17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the method of Barker to include the authenticate step for better securing the information.

Art Unit: 3621

As to claim 15, Barker does not specifically teach at least one document within a sent document folder has a printable representation. However, Kovnat teaches this matter. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow to method of Barker to include a printable document so that some of information can be printed for better viewing.

As to claim 16, Barker teaches does not explicitly teach at least one document folder comprises exactly one document. However, this matter is taught by Kovnat as each transmitted packet has a limited size (column 7 lines 33-40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the method of Barker to include at least one document folder comprises exactly one document so that some of the documents do not need fragmentation if the size of the document is small.

Claim 37 is rejected for the similar reasons as claims 11-14.

12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barker et al., U. S. Patent 6,233,252 in view of Walker et al., U. S. Patent 5,862,223.

As to claim 18, Barker does not specifically teach charging a recipient upon the recipient's taking delivery of an electronic document folder when the electronic document folder has been sent C. O. D. However, this matter is taught by Walker as a C. O. D. system that requires recipient to pay prior to delivery (column 22 lines 12-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the method of Barker to include the C. O. D. system so that the sender can be surely paid.

Art Unit: 3621

13. Claims 19-20 and 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barker et al., U. S. Patent 6,233,252 in view of Griswold, U. S. Patent 5,940,504.

As to claims 19-20, Barker does not specifically teach charging a recipient when the document folder has been stored on a network beyond an agree-upon period of time. Griswold teaches the license is expired is the present date is greater than license termination date (Fig. 7). Griswold does not specifically state charging the user if the product is used beyond the license termination date. It would have been obvious to one of ordinary skill in the art to allow Griswold to charge the user if the product is used beyond the license termination date so that the licensing owner can be better compensated. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the method of Barker to include charging recipient if the document is used beyond an agreed period of time so that the sender can be better compensated.

As to claim 34, the method of Barker modified by Griswold does not specifically teach sending C. O. D. It would have been obvious to one of ordinary skill in the art to allow the modified method to include sending C. O. D. so that the sender can be surely paid.

Claims 31-33 and 35-36 are rejected for the similar reasons as claims 19-20.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3621

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

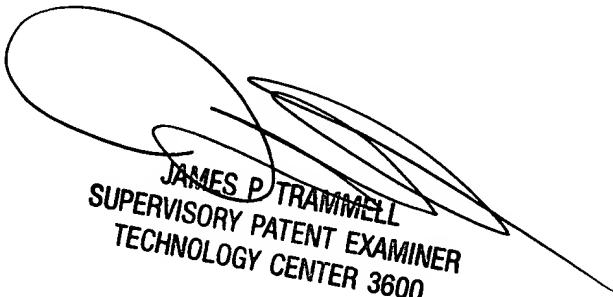
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306      (Official Communications; including After Final  
Communications labeled "BOX AF")  
(703) 746-5619      (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7<sup>th</sup> Floor Receptionist.

Mary Cheung  
Patent Examiner  
Art Unit 3621  
September 23, 2003

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600